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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 10/669,119 | 09/22/2003 | James D. Kelly | 18602-08098 (P2080R1C1) | 8760 |
| 758 | 7590 | 06/23/2004 | EXAMINER | |
| FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041 | | | RAY, GOPAL C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2111 | |

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,119

Applicant(s)

KELLY ET AL.

Examiner

Gopal C. Ray

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/19/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The examiner acknowledges the cancellation of original claims 1-17 and addition of new claims 18-19 by the Preliminary Amendment filed on 9/22/2003. Claims 18-19 are presented for examination.
2. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
3. Applicant should update first page of the specification of the invention to reflect the current status information. Furthermore, the specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The amendment to the Abstract is improper. Applicant should use BRACKETS not cross-through to amend the Abstract.
5. The declaration filed on 9/23/2003 is defective. It does not identify at least one error as per CFR 1.175(a)(1). In order for this reissue to be proper, the "identified error" must be corrected. The declaration identifies the errors as the failure to claim "an apparatus and a method of avoiding deadlock in a computer system by sending a retry signal to the bus transaction requestor if it is determined that execution of the bus transaction would cause deadlock". However, a totally different invention is claimed in the instant new claims 18 and 19. Claims 18 and 19 recite "an apparatus and a method for reordering transactions by slave devices without signaling a microprocessor of the computer system that the transactions are being ordered".

6. Claims 18-19 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

7. Claim 19 is objected to because the word --and-- should be inserted after ";" in line 3.

8. Claim 18 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner notes the following ambiguities. However, all claims should be revised carefully to eliminate all grammatical errors and antecedent basis problems.

As per claim 18, line 3, "any the slave devices" should be changed to --any of the plurality of the slave devices--.

9. Claim 18 would be allowable over the prior art considered if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in paragraph 8 above. Claim 19 would be allowable over the prior art considered if rewritten or amended to overcome the objection set forth in paragraph 7 above. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a). The following is an Examiner's Statement of Reasons for Allowance:

The instant application is a reissue of US Patent Application 10/006,939 which has become U. S. Patent 5,996,036. Applicant has cancelled original claims 1-17 and added new claims 18-19. The primary reasons for allowance is that the examiner has done complete search and found no prior art that teaches or fairly suggests, "an apparatus and a method for reordering transactions by slave devices without signaling a microprocessor of the computer system that the transactions are being ordered".

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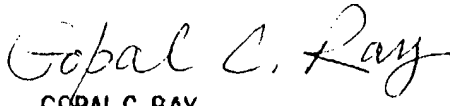
10. The prior art filed by applicant on 8/9/02 in the parent application has been considered by the examiner and made of record also in the instant file.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gopal C. Ray whose telephone number is (703) 305-9647. The examiner can normally be reached on Monday - Friday from 8:00 AM - 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [\[mark.rinehart@uspto.gov\]](mailto:mark.rinehart@uspto.gov).

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2100 receptionist whose telephone number is (703) 305-3900.


GOPAL C. RAY
PRIMARY EXAMINER
GROUP 2100